REMARKS

In the Office Action dated March 13, 2006, the Examiner rejected claims 32, 37-40, 45-48, and 53-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,870,723 to Pare, Jr. et al. in view of U.S. Patent No. 4, 825,050 to Griffith et al.; and rejected claims 33-36, 41-44, and 49-52 under 35 U.S.C. § 103(a) as being unpatentable over Pare, Jr. et al. in view of Griffith et al. and further in view of U.S. Patent No. 6,070,146 to Mimata.

Applicants wish to thank the Examiner for speaking with Applicants' representatives during a telephone interview on April 24, 2006. The remarks presented below are consistent with the topics discussed during the interview.

Applicants respectfully traverse the rejection of claims 32, 37-40, 45-48, and 53-56 under 35 U.S.C. § 103(a) as being unpatentable over Pare, Jr. et al. in view of Griffith et al. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims (*see* M.P.E.P. § 2143.03). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention (*see* M.P.E.P. § 2143). Third, a reasonable expectation of success must exist (*see* M.P.E.P. § 2143.02).

No *prima facie* case of obviousness has been established with respect to claim 32 for at least the reason that neither Pare, Jr. et al. nor Griffith et al., taken alone or in

combination, discloses or suggests every claim element. For example, independent

claim 32, from which claims 33-39 ultimately depend, recites a combination of elements

including, among other things, a verifier that verifies the integrity of the secure endorsed

transaction by comparing *a stored unique code* derived by decrypting the digital

signature using the second key with *a computed unique code* derived from the human

identifier and the transaction data. In contrast, Pare, Jr. et al. describes a biometric

input apparatus (BIA) that transmits a buyer's biometric and PIN data, and a data

processing center (DPC) that compares the biometric and PIN data with previously

registered biometric and PIN data submitted by the buyer. (*See* Pare, Jr. et al. col. 23,

lines 60-67 and Col. 24, lines 1-8). However, as discussed in the interview, comparing

biometric and PIN data with previously registered biometric and PIN data, as described

in Pare, Jr. et al., does not constitute comparing *a stored unique code* derived by

decrypting the digital signature using the second key with *a computed unique code*

derived from the human identifier and the transaction data, as recited in Applicants'

claim 32. Griffith et al., which was cited for its purported teaching of a digital signature

processor that generates a digital signature, fails to remedy this deficiency.

Similarly, no *prima facie* case of obviousness has been established with respect

to claim 40 for at least the reason that neither Pare, Jr. et al. nor Griffith et al., taken

alone or in combination, discloses or suggests every claim element. For example,

independent claim 40, from which claims 41-47 ultimately depend, recites a combination

including, among other things, verifying integrity of the secure endorsed transaction by

comparing *a stored unique code* derived by decrypting the digital signature using the

second key with *a computed unique code* derived from the human identifier and the transaction data. For at least the reasons noted above, comparing biometric and PIN data with previously registered biometric and PIN data, as described in <u>Pare, Jr. et al.</u>, does not constitute comparing *a stored unique code* derived by decrypting the digital signature using the second key with *a computed unique code* derived from the human identifier and the transaction data, as recited in Applicants' claim 40. <u>Griffith et al.</u>, which was cited for its purported teaching of a digital signature processor that generates a digital signature, fails to remedy this deficiency.

Similarly, no *prima facie* case of obviousness has been established with respect to claim 48 for at least the reason that the neither <u>Pare, Jr. et al.</u> nor <u>Griffith et al.</u>, taken alone or in combination, discloses or suggests every claim element. For example, independent claim 48, from which claims 48-56 ultimately depend, recites a combination of elements including, among other things, a means for verifying integrity of the secure endorsed transaction by comparing *a stored unique code* derived by decrypting the digital signature using the second key with *a computed unique code* derived from the human identifier and the transaction data. For at least the reasons noted above, comparing biometric and PIN data with previously registered biometric and PIN data, as described in <u>Pare, Jr. et al.</u>, does not constitute comparing *a stored unique code* derived by decrypting the digital signature using the second key with *a computed unique code* derived from the human identifier and the transaction data, as recited in Applicants' claim 48. <u>Griffith et al.</u>, which was cited for its purported teaching of a digital signature processor that generates a digital signature, fails to remedy this deficiency.

Because neither Pare, Jr. et al. nor Griffith et al., taken alone or in combination, discloses or suggests every element of independent claims 32, 40, and 48, or claims 37-39, 45-47, and 53-56 that depend therefrom, the 35 U.S.C. § 103(a) rejection of these claims is improper and should be withdrawn.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 33-36, 41-44, and 49-52 as being unpatentable over Pare, Jr. et al. in view of Griffith et al. and further in view of Mimata, for at least the reason that none of Pare, Jr. et al., Griffith et al., or Mimata, taken alone or in combination, discloses or suggests every claim element. For example, independent claim 32, from which claims 33-36 depend, recites a combination of elements including, among other things, a verifier that verifies the integrity of the secure endorsed transaction by comparing *a stored unique code* derived by decrypting the digital signature using the second key with *a computed unique code* derived from the human identifier and the transaction data. As noted above, neither Pare, Jr. et al. nor Griffith et al., taken alone or in combination, discloses or suggests at least this claim element. Mimata, which was cited for its purported teaching of a smart card input/output device, fails to remedy this deficiency. Thus, none of Pare, Jr. et al., Griffith et al., or Mimata discloses or suggests every element of independent claim 32, or claims 33-36 that depend therefrom.

Similarly, independent claim 40, from which claims 41-44 depend, recites a combination of elements including, among other things, verifying integrity of the secure endorsed transaction by comparing *a stored unique code* derived by decrypting the digital signature using the second key with *a computed unique code* derived from the

human identifier and the transaction data. As noted above, neither Pare, Jr. et al. nor

Griffith et al., taken alone or in combination, discloses or suggests at least this claim

element. Mimata, which was cited for its purported teaching of a smart card

input/output device, fails to remedy this deficiency. Thus, none of Pare, Jr. et al., Griffith

et al., or Mimata discloses or suggests every element of independent claim 32, or

claims 33-36 that depend therefrom.

Similarly, independent claim 48, from which claims 49-52 depend, recites a

combination of elements including, among other things, a means for verifying integrity of

the secure endorsed transaction by comparing a *stored unique code* derived by

decrypting the digital signature using the second key with a *computed unique code*

derived from the human identifier and the transaction data. As noted above, neither

Pare, Jr. et al. nor Griffith et al., taken alone or in combination, discloses or suggests at

least this claim element. Mimata, which was cited for its purported teaching of a smart

card input/output device, fails to remedy this deficiency. Thus, none of Pare, Jr. et al.,

Griffith et al., nor Mimata discloses or suggests every element of independent claim 32,

or claims 33-36 that depend therefrom.

Because none of Pare, Jr. et al., Griffith et al., or Mimata, taken alone or in

combination, discloses or suggests every element of independent claims 32, 40, and

48, or claims 33-36, 41-44, and 49-52 that depend therefrom, the 35 U.S.C. § 103(a)

rejection of these claims is improper and should be withdrawn.

Upon considering arguments made by Applicants' representative during the

interview, the Examiner suggested filing a Terminal Disclaimer in accordance with 37

C.F.R. § 1.321 to obviate an obviousness-type double patenting with respect to commonly-assigned U.S. Patent No. 6,745,936. Although Applicants may disagree with the Examiner's contention regarding the potential obviousness-type double patenting, Applicants nonetheless file concurrently herewith a Terminal Disclaimer in accordance with 37 C.F.R. § 1.321.
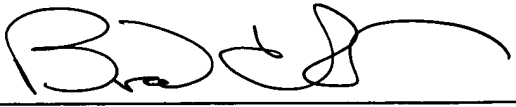
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement of characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 4, 2006   By:_____
                                Brad C. Rametta
                                Reg. No. 54,387